

## **REMARKS**

In the outstanding Office Action, the Examiner rejected claims 17-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,965,200 to Tateyama et al. ("Tateyama"); rejected claims 17-18 under 35 U.S.C. § 102(b) as being anticipated by JP 04-181143 to Nishi ("Nishi"); and rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Tateyama in view of U.S. Patent No. 6,692,165 to Tanaka et al. ("Tanaka"). By this amendment, Applicants have amended claim 17. Claims 17-19 remain pending.

### **I. Rejections under 35 U.S.C. § 102(b)**

Regarding the Examiner's rejection of claims 17-18, and 10 under 35 U.S.C. § 102(b), Applicants respectfully disagree with the Examiner's assertions and conclusions as set forth in the outstanding Office Action<sup>1</sup>. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference ... [t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 8th Ed. (Rev. 2), May 2004 (internal citations omitted). Applicants respectfully submit that neither Tateyama nor Nishi teach each and every element recited in claims 17-18, and thus cannot anticipate claims 17-18. Accordingly, Applicants respectfully traverse this rejection.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

A. Tateyama

Tateyama cannot anticipate claim 17 because that reference fails to teach at least “a suction nozzle arranged to face said target substrate for selectively sucking only a solvent vapor,” as recited in claim 17.

At page 2 of the Office Action, the Examiner asserts that Tateyama teaches “a suction nozzle ... considered to be *capable* of selectively sucking a solvent vapor” (emphasis added). Even if the Examiner’s characterization of Tateyama could be considered correct, Tateyama teaches “a suction nozzle 23 serving as a *processing liquid recovering means for recovering the processing liquid* on the substrate G under a suction force.” Tateyama, col. 5, lines 39-41 (emphasis added). Tateyama thus clearly teaches that suction nozzle 23 sucks processing liquid from the substrate, to recover the liquid. Accordingly, Tateyama fails to teach at least “a suction nozzle arranged to face said target substrate for selectively sucking only a solvent vapor,” as recited in claim 17 (emphasis added). Claim 17, is thus allowable over Tateyama, and claim 18 is allowable at least due to its dependence on claim 17.

B. Nishi

Nishi also cannot anticipate claim 17 because that reference fails to teach at least “a suction nozzle arranged to face said target substrate for selectively sucking only a solvent vapor,” as recited in claim 17.

At page 3 of the Office Action, the Examiner asserts that Nishi teaches “a suction nozzle ... considered to be *capable* of selectively sucking a solvent vapor” (emphasis added). Even if the Examiner’s characterization of Nishi could be considered correct, Nishi teaches “suction nozzle 2 is moved from a B point to an A point and lowered to

have reaction solution sucked,” and “sucked reaction solution is dripped onto a recovering vessel.” Nishi, English language abstract (emphasis added). Nishi thus clearly teaches that a liquid solution is sucked to recover the liquid solution.

Accordingly, Nishi fails to teach at least “a suction nozzle arranged to face said target substrate for selectively sucking only a solvent vapor,” as recited in claim 17 (emphasis added). Claim 17, is thus allowable over Nishi, and claim 18 is allowable at least due to its dependence on claim 17.

For at least the reasons set forth above, neither Tateyama nor Nishi anticipate claims 17-18. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 17-18 under 35 U.S.C. § 102(b).

## **II. Rejection under 35 U.S.C. § 103(a)**

Regarding the rejection of claim 19 under 35 U.S.C. § 103(a), Applicants respectfully traverse this rejection on the ground that a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. §2143.03 8th Ed. (Rev. 2), May 2004. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must “be found in the prior art, and not be based on applicant’s disclosure.” See M.P.E.P.

§ 2143 8th Ed. (Rev. 2), May 2004. At a minimum, the Examiner cannot establish that the references teach or suggest every element required by claim 19.

Claim 19 depends from claim 17, and thus requires all of the elements recited in claim 17. As discussed above, Tateyama fails to teach each and every element recited in claim 17. Tanaka, cited by the Examiner for allegedly teaching “the longitudinal suction width L (210 mm) nozzle 41 larger than the diameter of the substrate (8 in =203.2 mm),” fails to cure the above noted deficiencies of Tateyama. Office Action, page 4. Tanaka, similarly to Tateyama and Nishi, teaches “slit suction port 51 communicates with the pipe 45, for sucking and recovering the pure water supplied onto the substrate W through the pipe 45.” Tanaka, col. 12, lines 36-38 (emphasis added). Tanaka thus clearly teaches that pure water is sucked to recover the pure water. Accordingly, Tanaka fails to teach at least “a suction nozzle arranged to face said target substrate for selectively sucking only a solvent vapor,” as recited in claim 17, and required by claim 19 (emphasis added).

Because neither Tateyama nor Tanaka, whether taken alone or in combination, teach or suggest every element required by claim 19, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 19 under 35 U.S.C. § 103(a)

### III. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 17-19 in condition for allowance. Applicants submit that the proposed amendment of claim 17 does not raise new issues or

necessitate the undertaking of any additional search of the art by the Examiner.

Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

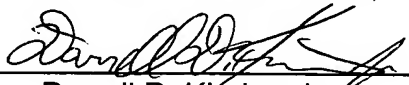
In view of the foregoing remarks, Applicants submit that claims 17-19, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 20, 2006

By:   
Darrell D. Kinder, Jr.  
Reg. No. 57,460